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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,315	08/10/2001	Takashi Hiraga	110345	8495
25944	7590	06/07/2004	EXAMINER	
OLIFF & BERRIDGE, PLC			GRAY, JILL M	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	

1774

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,315

Applicant(s)

HIRAGA ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory maximum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1, 3-10, 13-15, 17, 19, 20, 22, 24-26, 28 and 40-59 is/are pending in the application.
- 4a) Of the above claim(s) 42-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-10, 13-15, 17, 19, 20, 22, 24-26, 28, 40, 41 and 46-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other _____

DETAILED ACTION

Response to Amendment

The cancellation of claims 2, 11-12, 16, 18, 21, 23, 27, 29-39, and 60-63 is noted. Currently, claims 1, 3-10, 13-15, 17, 19-20, 22, 24-26, 28, and 40-59 are present, wherein claims 42-45 are non-elected per the restriction requirement of April 11, 2003.

The rejection of claims 1, 3-10, 13-17, 19-22, 24-26, 28, and 40-59 under 35 U.S.C. 103(a) as being unpatentable over Haigh, deceased et al, 4,465,728 and Haigh 4,059,471 is withdrawn in view of applicants' arguments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26, 28, and 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Haigh, deceased et al, 4,465,728, Haigh 4,059,471 (collectively Haigh) and Claveau, 5,308,426.

Haigh and Claveau each teach molded articles that have been subjected to sublimation dyeing as required by claims 26, 28, and 40-41. See abstracts. The fact that these claims are dependent upon the method of claim 1 is of no moment because patentability in product-by-process claims is based on the product itself. "[E]ven though product-by-process claims are limited by and defined by the process, determination of

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Therefore, the prior art teachings of Haigh and Claveau anticipate the invention as claimed in the present claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-10, 13-15, 17, 19-20, 22, 24-25, and 46-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claveau 5,308,426.

Claveau teaches a process of decoration sublimation comprising placing in a vacuum machine an organic compound having sublimation properties and an object, and heating to cause sublimation and transfer of the compound over the surface of the object as required by claims 1, 4-10, 13, 17, 22, 46-52. Claveau does not specifically teach cooling the vacuum chamber, however, this would have been an obvious process step to enable opening of the vacuum machine. In addition, Claveau teaches that the organic compound is contained in a sublimation source of the type contemplated by applicants and can be an ink, per claims 3, 14-15, and 53-59. As to specifics such as

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exhausting air through a vacuum, tightly closing the vacuum valves, these steps are obvious process steps that would be implicit in the vacuum molding process.

Accordingly, the general teachings of Claveau would have rendered obvious the invention as claimed in the present claims.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-10, 13-15, 17, 19-20, 22, 24-25, and 46-59 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

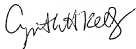
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-F 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray
Examiner
Art Unit 1774



CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
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